

No. 12,160

IN THE
United States Court of Appeals
For the Ninth Circuit

RALPH D. GOMEZ and WILLIAM HENDER-
SON, as individuals and co-partners
doing business under the name of
Gomez Manufacturing Company,

Appellants,

vs.

GRANAT BROS. (a corporation) and JOSEPH
GRANAT,

Appellees.

Appeal from the United States District Court for the
Northern District of California, Southern Division.

BRIEF FOR APPELLEES.

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PRELIMINARY.

There are but two issues here. One is, did the production of the device of the patent in suit involve invention? Determination of that issue also determines the second issue, which is, is the patent in suit valid?

We should point out to the Court that the attack on validity is that the production of the device of the patent did not involve invention. There is no issue here of infringement because appellants stipulated

infringement if the patent is valid. In fact, as the District Court found (finding 20—Tr. 33), the appellants' accused ring ensemble is substantially identical in construction and mode of operation to the ring illustrated, described and claimed in the patent in suit, and is a substantial copy of appellees' commercial ring ensemble made under that patent.

SUMMARY OF THE ARGUMENT.

1. In that appellants make no contention that the findings of fact of the District Court are not fully supported by substantial evidence, or that the District Court misapplied the law to the facts as found, this Court should refuse to re-try the facts and should not disturb the findings of fact of the District Court under rule 52(a) F.R.C.P., including the ultimate findings of invention and validity.

2. The prior art cited by the patent office during the prosecution of the application which resulted in the issuance of the patent in suit was the most pertinent prior art on the subject of the patent in suit, and the additional prior art offered in evidence was merely cumulative and therefore the patent in suit stands before this Court strengthened with the presumption of validity due to its issuance as well as the fact findings of the District Court that it involved invention and is valid.

3. The prior art does not anticipate the invention of the patent in suit in that the District Court found that the device of the patent in suit accomplishes a

result in a manner substantially different from the prior art and by means substantially different than the prior art, and produced the result in a novel and improved manner.

4. The patent claims are not for an exhausted and old combination under the rule of the "Barbed Wire Patent Case" *Washburn & Moen Manufacturing Co. et al. v. Beat 'Em All Barbed-Wire Co. et al.*, 143 U.S. 275, 12 S. Ct. 443, but to the contrary define a new and novel structure unanticipated by the prior art and involving invention.

5. The structure of the patent in suit does constitute invention and is not an obvious mechanical expedient for accomplishing the result, in that the District Court found that its production involved more than the skill of one skilled in the art and constituted invention.

6. The unusual commercial success of the device of the patent in suit is a factor which should be considered in this case, not as a substitute for invention but as evidence emphasizing the presence of invention in the device of the patent in suit.

7. The appellants here give tribute of their praise to the prior art, but gives the tribute of their imitation to the patented device by wilfully precisely copying it, when the prior art was open to their use.

ARGUMENT.

THE DISTRICT COURT'S FINDINGS OF FACT, BOTH EVIDENTIARY AND ULTIMATE, ARE COMPLETELY SUPPORTED BY SUBSTANTIAL EVIDENCE AND THE DISTRICT COURT PROPERLY APPLIED THE LAW TO THE FACTS.

Appellants make no contention that the findings of fact of the District Court are not fully supported by substantial evidence nor do appellants contend that the District Court misapplied the law to the facts as found. From appellants' brief it is manifest that what appellants are asking this Court to do is in effect to re-try the facts of this case *de novo*. This Court under rule 52(a) F.R.C.P.† and its decisions in the cases of *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 9 Cir., 151 Fed. (2d) 91, and *Bianchi v. Barili*, 168 Fed. (2d) 793, has consistently and properly refused to re-try the facts in patent cases on appeal and to disturb the District Court's findings of fact where the latter are fully supported by substantial evidence and are not clearly erroneous.

We urge that this case presents precisely the situation where such a rule should be applied. The District Court's findings on the evidence are detailed and precise and, as will be brought out later on herein, such findings are fully supported not only by substantial

†“* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial Court to judge of the credibility of the witnesses * * *.”

Federal Rules of Civil Procedure, Rule 52(a).

See also:

Maulsby v. Conzevoy, 161 Fed. (2d) 165, 9 Cir.;

Refrigeration Engineering, Inc. v. York Corporation, 168 Fed. (2d) 896, 9 Cir.

evidence but, for the most part, uncontradicted evidence.

Nowhere have appellants in their brief challenged this. Therefore, we urge that this Court under rule 52(a) F.R.C.P. should not disturb such findings of fact, including the ultimate findings of invention and validity. On this point we point out that there is no contention of non-infringement because appellants have admitted on page 7 of their brief:

“Admittedly, the ring ensemble manufactured by appellants comes within the scope of the patent in suit, * * *”.

We further emphasize that appellants nowhere in their brief challenge or argue that the District Court did not come to the proper legal conclusions upon the findings of fact as found by the District Court. Thus, the only issues raised here are factual ones, and appellants seek to have this Court re-try the facts and substitute new findings of facts for those of the District Court. In that the findings of fact of the District Court are supported by substantial evidence, we respectfully urge that this appeal should be dismissed.

APPELLANTS ON PAGE 7 OF THEIR BRIEF STATE: "The art cited by the Patent Office was woefully meager, and practically all of the prior art which should have been considered during the prosecution of the patent application was overlooked". THIS IS ENTIRELY ERRONEOUS AND IS CONTRARY TO THE DISTRICT COURT'S FINDING OF FACT.

The District Court found as a fact (finding 17—Tr. 33):

"17. That the prior art before the Patent Office was the most pertinent prior art on the subject of the patent in suit, and that the additional prior art offered in evidence was no closer to the patent in suit than that which was before the Patent Office during the prosecution of the application which resulted in the patent in suit."

In their brief appellants state to the Court (pages 7 and 8) that the prior art cited by the Patent Office was the combination of an engagement ring and a wedding ring held in locked engagement. Appellants complain, however, that the Patent Office did not cite four additional and similar patents, further removed from the patented structure than that cited by the Patent Office (according to the evidence and findings). This complaint by appellants despite the fact that appellants were unable at the trial to point out to the District Court and are now unable in their brief to point out to this Court that the additional patents were closer to the construction and mode of operation of the patented device than was the prior art cited by the Patent Office. Such citation of additional patents on the part of the Patent Office would have been merely cumulative and would have had no bearing on

the patentability of the patented device. Therefore, the Court's above finding is based on substantial evidence and should not be disturbed. The remaining patents which appellants complain were not cited by the Patent Office are for furniture, wooden tubs, building constructions, machinery in general, such as large pipe couplings and the like, and are totally unrelated to the subject of wedding ring ensembles, which is the subject of the patent in suit.

Appellants list these patents, which they contend the Patent Office failed to cite, on page 8 of their brief as follows (and we list the subject matter disclosed therein opposite each):

Kelly	152,233	(Discloses a large wooden tub, Tr. 83)
Kaas	424,211	(Ring)
Bullard	464,749	(Finger ring)
Linderman	517,348	(Lumber trimming-floors, Tr. 83)
Grierson	959,854	(Coupling for large pipe, Tr. 84)
Atkinson	942,047	(Coupling for large pipe, Tr. 83)
Tschirgi	1,482,772	(Concrete pipe joint, Tr. 84)
Thomas	1,536,540	(Ring)
Beaujard	1,712,417	(Ring)
Hubbard	1,715,293	(A drive shaft coupling, Tr. 85)
Mittleburg	1,829,366	(Wooden furniture, Pl. Ex. 3)
Birnbaum	1,877,750	(Removably attaching characters to an ornamental backing, Pl. Ex. 3)

The District Court, after examining all of these patents and considering all of the testimony found as a fact (finding 17 quoted above) that the prior art cited by the Patent Office was the most pertinent prior art. Therefore, this finding, being based upon sub-

stantial evidence, should not be disturbed, and appellants should not succeed in having this Court re-try the facts.

Therefore, we contend that the patent in suit comes to this Court with a strengthened presumption of validity attached to it because of its issuance in view of the most pertinent prior art, and also comes to this Court with the findings of fact of the District Court, both evidentiary and ultimate, that the structure shown in the patent amounted to an invention and that the patent is valid.

“* * * To the presumption of validity that attaches to a granted patent, where the most pertinent prior art has been cited against it in the patent office, there must probably now be added the force of a growing recognition of finality that is generally being accorded to administrative determinations supported by evidence, on the ground that the administrative agency is expected to have developed an expertness in its specific field beyond what may be expected from the courts wherein adjudications range the whole field of human controversies * * *.”

Williams Mfg. Co. v. United Shoe Mach. Corporation, 121 F. (2d) 273, 277 (C.C.A. 6, 1941 (Aff'd 316 U.S. 364, 86 L. Ed. 1537)).

APPELLANTS BASE THEIR APPEAL UPON THREE PROPOSITIONS (PAGE 12 APPELLANTS' BRIEF) THE FIRST OF WHICH IS "(a) Because the prior art fully anticipates the purported Granat invention", WHICH IS NOT ONLY CONTRARY TO THE DISTRICT COURT'S FINDING OF FACT BUT CONTRARY ALSO TO THE EVIDENCE.

As to anticipation, the District Court found as a fact that the Patent Office had considered the most pertinent prior art (finding 17—Tr. 33) before granting the patent. After an independent consideration of all the prior art cited by the appellants here, the District Court found as fact (Tr. 32-33):

"12. That while the prior art offered in evidence discloses wedding and engagement rings which latch together, the rings illustrated, described and claimed in the patent in suit accomplish that result in a manner substantially different than the prior art and by means substantially different than the prior art and produce the old result in a novel and improved manner.

"13. That the ring construction illustrated, described and claimed in the patent in suit No. 2,059,228 was not an obvious mechanical expedient for accomplishing the result, and its production involved more than the skill of one skilled in the art and constitutes invention."

* * * * *

"18. That the invention forming the subject matter of the patent in suit is not anticipated by the prior art in evidence herein."

The appellants nowhere in their brief contend that such findings of fact are not supported by substantial evidence and are clearly erroneous, nor do they con-

tend that such findings of fact are not supported by the preponderance of the evidence. In that appellants are unable to make such a showing, these findings of fact should not be disturbed by this Court under rule 52(a) F.R.C.P., as discussed on pages 4 and 5 of this brief.

THE SECOND BASIS OF APPELLANTS' APPEAL "(b) Because the patent claims are fatally defective in that they define an exhausted and old combination consisting of two connected finger rings together with a certain kind of connecting means, namely a dovetail tongue and groove or mortise and tenon connection, the invention if any residing in the connecting means per se" **IS ALSO CONTRARY TO THE DISTRICT COURT'S FINDINGS OF FACT AND TO THE EVIDENCE.**

As to the above quoted basis, which in effect is that the patent shows an exhausted and old combination, the District Court found as facts (Tr. 33-30):

"16. That although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general, the conception and practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was the result of more than mere mechanical skill and was the result of invention."

"5. That the claims of the patent in suit are not for an exhausted or old combination but properly define a patentable invention."

Appellants nowhere in their brief contend, nor show, that such findings of fact are not supported by substantial evidence or the preponderance of the evidence, and in that appellants fail so to do, these findings should not be disturbed by this Court.

The sole premise of appellants' argument that the patent shows an exhausted and old combination is not that the patented device does not differ from the prior art ring patents, but is based on the broad premise that the prior art shows a wedding ring and an engagement ring latched together albeit they are differently constructed so that they latch together.

Appellants then go on to argue that because the patented ring construction enabling latching resembles constructions which are old in the furniture and other entirely unrelated arts, the patented device is nothing more than an exhausted and old combination. The fallacy of this argument is that no prior art patent shows a latching construction equivalent to the patented device in connection with wedding and engagement rings, and *no patent teaches how such a latching construction could be applied to wedding and engagement rings*. The District Court recognized this and such is the basis of the District Court's finding 16 (Tr. 33):

“16. That although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general, the conception and

practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was the result of more than mere mechanical skill and was the result of invention.”

Manifestly, appellants have not shown that the above quoted finding is in error, or is not based upon substantial evidence. Consequently, appellants’ contention that this finding is clearly erroneous should be rejected and the finding should not be disturbed. Appellants, in making the above argument, mistakenly argue that a device to be invention, all individual parts thereof must be novel. This is clearly erroneous. A patent on a combination of any sort, in the language of the authorities, pre-supposes that all of the parts may be old.

There are numerous decisions to the effect that the fact all of the elements of a claimed combination are individually old does not detract from the patentability of the combination if the combination be new.

“* * * Conceding for the purpose of the argument, *that the elements are all old* and that each element used produces no new result, yet we are convinced that a beneficial result has been produced in a more efficient, economical and facile manner, and we feel constrained to hold the claims valid. *New York Scaffolding Co. v. Whitney*, 8 Cir., 224 F. 452.” (Italics ours.)

E. R. Wagner Mfg. Co. v. Porter Steel Specialties, 116 F. (2d) 63, 67 (C.C.A. 7, 1940).

“In discussing the validity of the patent in suit, *it may be admitted that all the elements in appellee’s structure were old in the art.* Appellee claims, however, that its structure is a new combination of these elements which produces a novel and useful result (or an old result in a more facile, economical, and efficient way). If this be true, it is sufficient to uphold the patent. *New York Scaffolding Co. v. Whitney (C.C.A.), 224 F. 452.*” (Italics ours.)

Young Radiator Co. v. Modine Mfg. Co., 55 F. (2d) 545, 546 (C.C.A. 7, 1931.)

The facts of this case are quite close to the facts of the leading case of *Washburn & Moen Manufacturing Co. et al. v. Beat ’Em All Barbed-Wire Co. et al., 143 U.S. 275, 12 S. Ct. 443* (the barbed wire patent). In that case our Supreme Court held valid a patent on what we now know as barbed wire. The prior art there considered consisted of twisted fence wire having spaced barbs strung thereon. The invention consisted in making the barbs out of short pieces of wire and twisting such barbs about the fence wire for the purpose of attachment. Obviously, it was not new prior to that time in other arts to connect two wires together by intertwisting. The Supreme Court held that although the change was a simple one, the new structure was a very meritorious invention and sustained the patent.

In the present case the District Court, in view of all of the evidence, found as a fact (finding 15—Tr. 32) that the production of the particular ring ensemble

described and claimed in the patent in suit was the first in the art to provide a commercially *practical* ring ensemble or set of a wedding ring and engagement ring capable of being latched together to prevent relative rotation and axial movement when worn upon the finger.

The District Court also thoroughly considered the prior art and its effect on the patent in suit, and in particular considered the precise question raised by appellants, and after such consideration found as a fact (finding 16—Tr. 33) that although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general (shown by prior art patents which appellants complain were not cited by the Patent office), *the conception and practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was the result of more than mere mechanical skill and was the result of invention.*

We therefore, contend that the findings of fact, both evidentiary and ultimate, as to exhausted combination and invention were not only based upon substantial evidence but upon the preponderance of the evidence, and that these findings of fact should not now be disturbed by this Court under rule 52(a) F.R.C.P.

THE THIRD AND FINAL BASIS OF APPELLANTS' APPEAL FOR REVERSAL OF THE DISTRICT COURT "(c) Because the combination of the patent in suit does not constitute invention" IS CONTRARY TO THE DISTRICT COURT'S FINDINGS OF FACT, WHICH FINDINGS OF FACT ARE SUPPORTED BY SUBSTANTIAL EVIDENCE AND SHOULD NOT BE DISTURBED BY THIS COURT.

On the question of invention the District Court found as a fact (Tr. 32-33):

"13. That the ring construction illustrated, described and claimed in the patent in suit No. 2,059,228 was not an obvious mechanical expedient for accomplishing the result, and its production involved more than the skill of one skilled in the art and constitutes invention.

"14. That the ring construction illustrated, described and claimed in the patent in suit No. 2,059,228 was not the result of mere mechanical skill but was the result of the inventive faculty.

"15. That the patentee of the patent in suit by producing the ring ensemble or set illustrated, described and claimed in the patent in suit was the first in the art to provide a commercially practical ring ensemble or set of a wedding ring and engagement ring capable of being latched together to prevent relative rotation and axial movement when worn upon the finger.

"16. That although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general, the conception and practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was

the result of more than mere mechanical skill and was the result of invention.”

Appellants in their brief do not contend, nor show, that these findings of fact were not based on substantial evidence or the preponderance of the evidence, but are again asking this Court to re-try the facts merely because of their contention that the District Court was in error.

In the argument appellants argue (page 35 of their brief):

“In each of the patents to Kaas, Bullard, Thomas and Harris is found two finger rings held in joined relationship by mechanical connecting means (*not the mechanical connecting means of the patent*). * * * Granat’s (*patentee*) connecting means performs no new function. * * * In so far as the connecting means per se is concerned it embodies the same elements and functions in the exact manner as the dovetail tongue and groove or mortise and tenon connecting means disclosed in Atkinson, Grierson, and the various other representative patents listed herein.” (Inserts ours.)

These latter patents are precisely the ones which the District Court was referring to in its finding 16 (Tr. 33) when it said that “although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general”.

The Court’s attention, however, is directed to the fact, first, that the District Court found in finding of fact 12 (Tr. 32) that while the prior art offered in

evidence discloses wedding and engagement rings which latch together, the patented structure *accomplished that result in a manner substantially different than the prior art and by means substantially different from the prior art, and produced the old result in a novel and improved manner.*

Appellants ignore in their argument that where one produces an "old result in a new, different and improved manner", he has produced a patentable device.

"* * * So a new combination of known devices, whereby the effectiveness of a machine is increased, may be the subject of a patent * * *."

Cantrell v. Wallick, 117 U.S. 689, 29 L. Ed. 1017, at 1018 (1886).

"With respect to the result produced, it is not essential that it be a wholly new result, but it is sufficient if an old result is effected in a more facile, economical, or efficient way. *Galvin Elec. Mfg. Co. v. Emerson Elec. Mfg. Co.* (C.C.A. 8), 19 F. (2d) 885, 888; *Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co.* (C.C.A. 8), 215 F. 362, 369; *New York Scaffolding Co. v. Whitney* (C.C.A. 8), 224 F. 452, 456; *National Hollow Brake-Beam Co. v. Interchangeable B.-B. Co.* (C.C.A. 8), 106 F. 693, 706, 707; *Skinner Bros. Belting Co. v. Oil Well Imp. Co.* (C.C.A. 10), 54 F. (2d) 896; *Grinnel Washington Mach. Co. v. E. E. Johnson Co.*, 247 U.S. 426, 432, 38 S. Ct. 547, 62 L. Ed. 1196."

Independent Oil Well Cementing Co. v. Halliburton, 54 F. (2d) 900, 905 (C.C.A. 10, 1932), (cert. denied 286 U.S. 544, 76 L. Ed. 1281).

“The result need not be new. It is sufficient if an old result be produced in a more facile, economic or efficient way. *Willard v. Union Tool Company*, 9 Cir., 253 F. 48; *New York Scaffolding Co. v. Whitney*, 8 Cir., 224 F. 452.”

Long v. Dick, 38 Fed. Supp. 214, 220 (Calif. D.C. 1941).

Secondly, appellants ignore the the District Court's finding 16 (Tr. 33) wherein the Court considered that although the dovetail connection was widely used in unrelated arts, such as furniture making and the machinery business in general, that the application of the principle of such device to wedding and engagement ring ensembles was not obvious and was the result of more than mechanical skill and, in fact, the result of invention. Appellants have not shown that this finding is not supported by the evidence or is clearly erroneous.

Appellants further ignore *and do not tell this Court in their brief where the prior art patents, taken singly or together, teach how a dovetail connection or a mortise and tenon connection could be applied to wedding ring ensembles*. Appellants fail so to do for the obvious reason that the prior art does not so teach or disclose such a teaching. Here again the “Barbed Wire Patent” case above cited, *Washburn & Moen Manufacturing Co. et al. v. Beat 'Em All Barbed-Wire Co. et al.*, 143 U.S. 275, 12 S. Ct. 443, is referred to because of its similarity of facts to the present case. There the prior art showed fence wire with barbs on it. Also, obviously it was old to connect two wires

together by twisting them in other arts. However, the patented structure was the first to make use of a barb of wire intertwisted with the fence wire to make a practical barbed wire fence, which act our Supreme Court held to be an inventive one. If appellants' argument in the present case is sound, then the "Barbed Wire Case" was erroneously decided.

ON PAGE 40 OF APPELLANTS' BRIEF APPELLANTS CONTEND "Commercial success has no weight here". TO THE CONTRARY WE BELIEVE THE COMMERCIAL SUCCESS OF THE PATENTED STRUCTURE IS A FACTOR TO BE CONSIDERED IN THIS CASE.

We are well aware of the rule, as reiterated by this Court, that commercial success cannot be substituted for invention. However, in a case such as the one at bar, where the District Court has found that the patented device accomplishes an old result in a novel and improved manner and in a way substantially different from the prior art, and that such patented device was the result of more than mechanical skill and in fact the result of invention, commercial success is a factor to be considered, particularly, when, as here, the appellants seek to have this Court set aside such findings of fact without showing that they are clearly erroneous and without showing that they are not based on substantial evidence and the preponderance of the evidence.

We call this Court's attention to the fact that the District Court found from the evidence (Tr. 92) (find-

ing 7—Tr. 30) that long prior to the issuance of the patent in suit there was a recognized need or want in the jewelry trade for a practical wedding and engagement ring set that would latch together to prevent relative rotation and axial movement between the rings when worn on a finger. The District Court also found as a fact and based upon substantial evidence (Tr. 90-91) (finding 8—Tr. 30), that prior to the patent owner's production in 1934 of the ring structure shown in the patent in suit there were no ring ensembles on the market or offered for sale commercially in which the rings would latch together to prevent relative rotation and axial movement between the rings when worn on the finger. The District Court then went on in finding 9 (Tr. 31) to find from the evidence (Tr. 97 to 101) that upon the production by the patent owner of the ring ensemble of the patent in suit in 1934 such ring ensemble satisfied the long felt want or need in the jewelry trade for a wedding and engagement ring set which would latch together and prevent relative rotation and axial movement between the rings when worn upon the finger.

Further, the District Court from the evidence (Tr. 100-101) found in finding 10 (Tr. 31) that upon the production of the patented device in 1934 there was an immediate and widespread commercial demand for the patented ring, and that from the year 1934 on, the patent owner yearly sold approximately \$125,000 worth of the patented ring ensembles all over the United States.

Certainly, the above findings by the District Court and the evidence concerning the same are factors to be considered in determining whether an invention is present in the patented device. If it was so obvious from the prior art that such a ring structure could be produced, why then was there a long felt want in the jewelry trade for such a structure? Our answer is, of course, as is the answer of the District Court, that the production of the patented structure was not an obvious one and not a mere application of skill, but in fact one of invention.

The case at bar in this regard parallels the facts of the "Barbed Wire Patent Case", *Washburn & Moen Manufacturing Co. et al. v. Beat 'Em All Barbed-Wire Co. et. al.*, 143 U.S. 275, 12 S. Ct. 443, in which the Supreme Court, in holding the patent valid, stated:

"It is true that the affixing of barbs to a fence-wire does not apparently give a wide scope to the ingenuity of the inventor; but from the crude device of Hunt to the perfected wire of Glidden, each patent has marked a step in the progress in the art. The difference between the Kelly fence and the Glidden fence is not a radical one, but, slight as it may seem to be, it was apparently this which made the barbed-wire fence a practical and commercial success. The inventions of Hunt and Smith appear to be scarcely more than tentative, and never to have gone into general use. The sales of the Kelly patent never seem to have exceeded 3,000 tons per annum, while plaintiff's manufacture and sales of the Glidden device (substituting a sharp barb for a blunt one) rose rapidly from 50 tons in 1874 to 44,000 tons in 1886,

while those of its licensees in 1887 reached the enormous amount of 173,000 tons. * * *

“Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents it is the last step that wins.”

Again comparing the case at bar to the “Barbed Wire Case”, the District Court found from the evidence there had been no successfully latched ring sets offered commercially prior to the patented one, and that immediately upon its commercial introduction, over \$125,000 per year were sold by the patent owner. Notice that the District Court also found from the evidence that prior to the production of the patented device, there was an actual long felt want and need in the jewelry trade for such a device. From this we argue that the production of the patented device was not an obvious expedient but was in fact an invention. The District Court certainly felt this way about it from the evidence.

Appellants seem to make some sort of a contention that some of the ring ensembles sold by the patent owner were not of the same construction as that shown in the patent. This is erroneous in view of the exact testimony. Mr. Joseph Wineroth (Tr. 100-101) testified in detail that the commercial success and sales above indicated were attributable to devices constructed precisely in the manner shown in the patent in suit, so that appellants’ vague assumption that the commercial success might be attributable to ring en-

sembles other than the patented device is not in accordance with either the testimony or evidence, or with the Court's precise finding of fact on the matter, which is as follows (Tr. 33):

“19. That defendant-cross-plaintiff's commercially successful ring ensembles were substantially identical in construction and mode of operation with that illustrated, described and claimed in the patent in suit No. 2,059,228.”

THE APPELLANTS HERE GIVE TRIBUTE TO THE PRIOR ART BY THEIR CONTENTION THAT THE PATENTED STRUCTURE DID NOT AMOUNT TO INVENTION THEREOVER, YET THEY PAY TRIBUTE TO THE PATENTED DEVICE BY WILFULLY PRECISELY COPYING IT.

Under the title “Appellants' Ring Ensemble” on pages 6 and 7 of appellants' brief appellants seem to argue (contrary to the Court's finding) that appellants innocently infringed. This, however, is contrary not only to the District Court's finding of fact 22 (Tr. 34):

“22. That plaintiffs' cross-defendants' infringement of the patent in suit No. 2,059,228 was done knowingly and deliberately and in disregard of said patent No. 2,059,228 and defendant-cross-plaintiff's rights thereunder.”

but is also contrary to the evidence. Mr. Wineroth (Tr. 105-106) testified that during the period from 1939 to 1941, inclusive, appellant Gomez set diamonds in approximately 3500 rings for the appellee here, between 18% and 22% of which were rings constructed exactly

in accordance with the patent in suit. Mr. Gomez did not deny this, but merely stated that he had never seen the patented structure before he made it. Yet, appellants admit in their brief (page 7) and the District Court found as a fact that the infringing device was almost an exact duplicate of the patented structure, as shown in the patent. The District Court had the witnesses in front of it, and from that testimony found as a fact (finding 22—Tr. 34) as above stated that the infringement was wilfull and in disregard of the patent. That finding, being supported by substantial evidence, should not be disturbed and appellants' contention in the brief of "innocent" infringement cannot be sustained. In all of this we recognize that innocent or not, the tort of infringement is complete, when the act of duplicating the patented device is performed.

However, we make the above point solely for one reason and that is that although appellants say that the prior art patents completely anticipate the patents in suit, they have copied the device of the patent in suit. Thus, with all of the prior art open which they could duplicate without any litigation and without any charge or liability of infringement, they chose instead to duplicate the patented structure. By so doing, they have paid to the patented device the high tribute of imitation and it does not come well from their mouths to contend lack of invention.

In this connection we are reminded of the language of Justice McKenna in *Diamond Rubber Co. v. Con-*

solidated Rubber Tire Company, 220 U.S. 426, 55 L. Ed. 527:

“* * * We see the strength of the concession to its (the patent’s) advance beyond the prior art and of its novelty and utility by the rubber company’s imitation of it. The prior art was open to the rubber company. That ‘art was crowded,’ it says, ‘with numerous proto-types and predecessors’ of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. *It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done.*” (Italics ours.)

CONCLUSION.

We respectfully urge this Court that the appeal here should be dismissed on the grounds that the evidentiary and ultimate facts as found by the District Court are all fully supported by substantial evidence, and that the District Court did not misapply the law to the facts as found by it.

We call the Court’s attention to the fact that the factual situation in the case at bar precisely fits the statement made by this Court in *Bianchi v. Barili*, decided by this Court on June 15, 1948, and reported at 168 Fed. (2d) 793:

“Before a patent can be declared invalid because of anticipation, its lack of novelty must be established beyond a reasonable doubt. *Cantrell v. Wallick*, *supra*, 117 U.S. at pages 695, 696;

1 Walker §63, pages 300-303; American Bell Telephone Co. v. People's Telephone Co., C.C. N.Y., 22 F. 309, 313, affirmed, 126 U.S. 1, 572, 8 S. Ct. 778, 31 L. Ed. 863; Searchlight Horn Co. v. Victor Talking Machine Co., D.C.N.J., 261 F. 395, 401.

“Particularly heavy is the attacker’s burden when the validity of the patent has been sustained by court findings. General Motors Corporation v. Kesling, 8 Cir., 164 F. (2d) 824, 827, certiorari denied on March 15, 1948, 333 U.S. 855, 68 S. Ct. 732, and the many cases there cited.”

We respectfully submit that the judgment of the District Court may be affirmed.

Dated, San Francisco, California,

April 20, 1949.

Respectfully submitted,

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